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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,754	09/22/2000	Tuomas Eerola	107436	8730

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Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,754

Applicant(s)

EEROLA ET AL.

Examiner

Paul Nguyen-Ba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/22/00.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☒ Claim(s) 1-11 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This action is responsive to:
 - a. Pre-Amendment A filed on September 22, 2000, and
 - b. Request for Correction of PALM Records received on March 29, 2001.
2. Claims 1-11 have been considered. Claims 1, 7, 10, and 11 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would

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result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. §101.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Objections

6. Claims 1-11 objected to because of the following informalities:
- a. Please remove citation numbers to the drawings within the claims, and
 - b. Please remove the bold formatting from the word “characterized.”
- Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Light, U.S. Patent No. 6,389,412.

Independent Claims 1, 7 and 10

Light discloses a method for publishing a document, equipment for supporting a text search, and a document comprising at least a text part for one or more users (see Title and Abstract), *the document is subjected to at least one indexing to enhance real-time search of the document, and the result of the indexing is stored* (col. 9, lines 58-64 → server processor may store “document search index”),

characterized in that before the at least one indexing, the document is complemented by adding a complementary part thereto (i.e. integrated metadata), the complimentary part substantially comprising at least the words included in the text part of the document, given in their basic form and original order (Fig. 2; see col. 5, lines 62 *et seq.* → list of distinguishing terms contain at least the common terms in the document set in their basic form).

Claim 2

Light further discloses a method wherein the *complimentary part* (i.e. metadata) *is added to the document in a way which prevents the complimentary part from being shown during normal use of the document* (col. 5, lines 7-16 → metadata is transparent to the user).

Claim 3

Light further discloses a method wherein for each compound, the *complimentary part* (i.e. metadata) *comprises not only the basic form of the compound* (Fig. 8; col. 5, lines 17-34) *but also basic forms of the parts of the compound given as separate words* (Fig. 3; col. 5, lines 35-61; col. 7, lines 8-32 → alternate forms of the compound).

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Claim 4

Light further discloses a method wherein the complimentary part further comprises *all combinations of the parts of a compound* (Fig. 3; col. 5, lines 35-61; col. 7, lines 8-32 → alternate forms of the compound) *where the parts are in their original order* (col. 8, lines 60-67 to col. 9, lines 1-4 → entries occur in the term list in the order in which they first appear in the document).

Claim 5

Light further discloses a method wherein a *plural number of documents are published using a plural number of publishing servers* (col. 4, lines 1-7 → document set made public by storing on or near the server) *and that the complimentary part is added at a complimentary server* (Fig. 1; col. 9, lines 65 *et seq.* → i.e. server processor) *which is common to a plural number of publishing servers.*

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Light, U.S. Patent No. 6,389,412.

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Claims 6 and 8

Light further discloses a method and equipment wherein the complimenting server receives and transmits the documents to be complemented via a telecommunication network (col. 4, lines 1-7; col. 9, lines 58 *et seq.*), but does not specifically disclose employing an IP protocol.

However, it is commonly known to those of ordinary skill in the art that an IP protocol is often used in networks to establish a virtual connection between a destination and a source for the purpose of exchanging streams of data via the Internet.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Light to incorporate an IP protocol for the purpose of exchanging streams of data via the Internet.

Claims 9 and 11

Light further discloses an arrangement for publishing documents via a telecommunication network, the arrangement comprising at least one publishing server for publishing the documents (col. 4, lines 1-7 → document set made public by storing on or near the server), at least on indexing server for indexing the documents (col. 9, lines 58-64 → server processor may store “document search index”), and at least one terminal equipment for transmitting an inquiry to the at least one indexing server (col. 17, lines 62-65; col. 18, lines 63-65), but does not specifically disclose a network applying an IP protocol.

However, it is commonly known to those of ordinary skill in the art that an IP protocol is often used in networks to establish a virtual connection between a destination and a source for the purpose of exchanging streams of data via the Internet.

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It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Light to incorporate an IP protocol for the purpose of exchanging streams of data via the Internet.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,480,835	issued on	November 12, 2002	Light
6,151,624	issued on	November 21, 2000	Teare et al.
6,701,307	issued on	March 2, 2004	Himmelstein et al.
6,360,215	issued on	March 19, 2002	Judd et al.
6,044,375	issued on	March 28, 2000	Shmueli et al.

Meta Tag Tutorial, www.webdeveloper.com/html/html_metatages.html, updated on November, 1998.

Magic META Tags, www.website.freesevers.com/meta.htm, circa 1998.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (703) 305-8776. The examiner can normally be reached from 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER